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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/403,392	10/21/2001	Rupert Austin	3525-28	7217

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EXAMINER

TRUONG, TAMTHOM NGO

ART UNIT	PAPER NUMBER
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1624

DATE MAILED: 12/29/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/403,392

Applicant(s)

AUSTIN ET AL.

Examiner

Tamthom N. Truong

Art Unit

1624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 16 October 2003.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-12 and 15-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 6 and 8-10 is/are rejected.
- 7) ☒ Claim(s) 1-5, 7, 11, 12, and 15-17 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. §§ 119 and 120**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All   b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)                      4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)                      5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_                      6) ☐ Other: \_\_\_\_\_

### FINAL ACTION

Applicant's amendment of 10-16-03 has been fully considered. Although the amended claims 8-10 have overcome the previous rejection of 112/2<sup>nd</sup> paragraph, they necessitate the following new ground(s) of rejection. Also, the amended claim 12 is an improper multiple dependent claim.

The cancellation of claims 13 and 14 has obviated the previous rejections of 112/2<sup>nd</sup> paragraph and "Use Claims". Also, applicant's argument has overcome the previous rejections of "Scope of Enablement" and "Enablement". Thus, said rejections are withdrawn herein.

With claims 13 and 14 cancelled, only claims 1-12, and 15-17 remain for consideration.

### *Claim Rejections - 35 USC § 112*

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

1. **Lack of Written Description:** Claims 8-10 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claims contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claims 8-10 recite compounds of formulae V, VII, and IX having variables of  $L^2$ ,  $L^3$ , and  $(L^4, L^5)$  respectively. However said variables represent

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“leaving group”, which does not appear to have a description in the specification. On page 28, the specification merely discloses  $L^2$  and  $L^3$  as “preferably a bromine atom”, and  $L^4$  as “preferably a chlorine atom”. Thus, one cannot be ascertained whether the scopes of  $L^2$ - $L^5$  are the same (i.e., they only represent halogen atoms), or different (i.e., they represent other moieties, functional groups, etc.). Because the scopes of  $L^2$ - $L^5$  are indeterminate, the structures of formulae V, VII, and IX lack written description.

2. **Enablement:** Claims 8-10 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claims contain subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. As mentioned in the above paragraph, said claims recite formulae V, VII, and IX, that do not have written description. Considering these are “novel intermediates” as pointed out on page 28 of the specification, one skilled in the art would need guidance in terms of what constitutes a “leaving group” besides halogen atoms. Also, it appears that the specification does not provide guidance on how said “novel intermediates” can be prepared. Thus, when  $L^2$ - $L^5$  represent a group other than a halogen atom, one skilled in the art would have to carry out undue experimentation to make intermediates of formulae V, VII, and IX.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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3. Claim 6 recites species having X as (=O), and hence the name of "...thiazolo[4,5-d]pyrimidin-7(4H)-one". There is insufficient antecedent basis for this limitation in the claim. Note, claim 6 depends on claim 1 which recites X as -OH, and not as (=O). Claim 1 does not recite the limitation of 'a tautomer thereof' either. Thus, the species in claim 6 do not have antecedent basis in claim 1.

Claim 6 also recites more species than Rule 1.141 allows. Note, Rule 1.141 allows a claim to recite more than one species, "**not to exceed a reasonable number**". In the instant case, claim 6 has pages of species, which obviously more than Rule 1.141 allows.

#### *Claim Objections*

4. Claim 12 is objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim should refer to other claims in the alternative only. See MPEP § 608.01(n). Accordingly, the claim 12 has not been further treated on the merits.

5. Claims 1-5, 7, 11, 12, and 15-17 are objected to because of the following informalities:

a. Claims 1-5 and 7 recite the phrase "may be" or "may itself be" which does not suggest a positive affirmation. Applicant is suggested to replace said phrase with the verb "is".

b. Claims 11, 12, and 15-17 are objected as being dependent on claim 1  
Appropriate correction is required.

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Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).


Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tamthom N. Truong whose telephone number is 703-305-4485. The examiner can normally be reached on M-F (7 am -12 pm, and 3 pm - 6 pm) starting from 10-1<sup>st</sup> -03.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mukund Shah can be reached on 703-308-4716. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-4556 for regular communications and 703-308-4556 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1235.

  
T. Truong

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December 17, 2003

  
MUKUND J. SHAH  
SUPERVISORY PATENT EXAMINER  
GROUP 1200